

REMARKS

The Office Action mailed on September 21, 2007, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 16-28 and 30-45 were pending. By this paper, Applicant cancels claims 18, 19 and 33-34, and adds claims 46 and 47. Therefore, claims 16, 17, 20-28, 30-32 and 35-47 are now pending.

Applicant respectfully submits that the present application is in condition for allowance for at least the reasons that follow.

Drawing Objections

The drawings are objected to as failing to depict each feature of claim 19. Applicant has cancelled claim 19, and thus the drawing objections are now moot.

Claim Objections

Claims 21, 24, 33, 36 and 44 stand objected to as allegedly containing informalities. In response, in order to advance prosecution, and without prejudice or disclaimer, these claims (or the respective independent claims, as appropriate) are amended, and reconsideration is requested.

Applicant thanks Examiner Han for taking the time to recommend changes to some of the claims to alleviate the objections; changes that Applicant has embraced.

Rejections Under 35 U.S.C. §112, First Paragraph

Claims 19 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. As noted above, claim 19 has been cancelled in the interests of

advancing prosecution, without prejudice or disclaimer, and thus the rejection of claim 19 is now moot.

Rejections Under 35 U.S.C. § 103

Claims 16-18, 20-21, and 23-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baba (U.S. Patent No. 4,729,18) in view of Anderson (U.S. Patent No. 6,464,381). Claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baba in view of Anderson as applied to Claim 21, and further in view of Miller (U.S. Patent No. 6,227,689). Claims 25-28 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baba in view of Anderson as applied to Claim 16, and further in view of Parker (U.S. Patent No. 6,895,115). Claims 31-36 and 43-45 stand rejected under the same statute as being unpatentable over Baba in view of Anderson. Claim 37 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Baba in view of Anderson (U.S. Patent 6,464,381) as applied to Claim 36, and further in view of Miller. Claims 38-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Baba in view of Anderson as applied to Claim 31, and further in view of Parker (U.S. Patent No. 6,895,115).

In response, in order to advance prosecution, and without prejudice or disclaimer, Applicant hereby places the recitations of claim 18 into claim 16 (effectively placing claim 18 into independent form), places the recitations of former pending claim 16 and claim 21 into claim 22 (placing claim 22 into independent form), places the recitations of former pending claim 16 and claim 23 into claim 24 (placing claim 24 into independent form), places the recitations of claims 33 and 34 into claim 31 (effectively placing claim 34 into independent form), and places the recitations of former pending claim 31 into claim 44 (placing claim 44 into independent form).

Applicant traverses the assertion that at least formerly pending claims 18 (now claim 16), 22, 24, 34 (now claim 31), and 44 are obvious for at least the following reasons.

The Cited References Do Not Suggest All Claim Recitations

Even if the requirement that there be a reasonably articulated rationale for modifying/combining the cited references were considered satisfied in the Office Action

(which it is not, as explained below), the cited references still do not meet the third requirement of MPEP § 2143, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Claims 22 and 37: Claims 22 and 37 recite a lining element comprising a translucent covering layer. Claim 22 recites that the translucent covering layer comprises an elastomer that has a hardness of 20 to 70 Shore A. Claim 37 recites that the translucent covering layer comprises an elastomer that has a hardness of approximately 40 Shore A. An exemplary embodiment of the inventions of claims 22 and 37 may be seen in Fig. 1, where translucent covering layer 3 covers the optical conductor 10, and has a hardness (as recited) in expectation of repeated contact with humans / other structures, *etc.*

It is submitted that the recitation that the covering layer be “translucent” while at the same time having the recited hardness are not features of claims 22 and 37 has been disregarded by the Office. Specifically, the Office Action recognizes that the alleged Baba - Anderson combination is completely deficient as to the recited hardness. Indeed, the alleged combination results in a soft covering layer (concomitant with the goal of those references (and traditional approaches in the field, prior to Applicant’s advancement in the art) to have a “soft” feel to the device).

Miller is introduced in an attempt to remedy this deficiency of Baba-Anderson. Even if Miller teaches use a material that has a hardness that falls within the range of claim 22 (but not claim 37). Claims 22 and 37 recite that the material must be translucent. Miller does not teach or suggest that the material of element 16 is translucent. Moreover, there is no reason why element 16 would be translucent. In the configuration of Mille, element 16 is a mere lamp holder. As the light from lamp 22 is not needed above mounting panel 13 (instead, it is needed to be transmitted through light 29), to the extent that Miller suggests anything, it suggests that element 16 is opaque. (Bare electrical leads are not visually appealing, and it is likely that an opaque material would be used so as to hide the electrical leads from the driver, *etc.* Also, the skilled artisan would not have wanted light from the lamp to escape into the mirror section.)

In view of the above, replacement of the elastomer material of the Baba – Anderson combination with the material of element 16, even if it does have the recited hardness, would

still not result in a translucent material, and thus at least this element is not taught in the resulting combination. Therefore, claims 22 and 37 are not obvious for at least this reason.

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In view of the deficiencies of Miller regarding the exacting recitation of “approximately 40 Shore A” of claim 37, the Office Action relies on *In re Aller* in an attempt to alleviate the deficiencies of Miller vis-à-vis a proper obviousness rejection. The error associated with relying on *In re Aller* in the Office Action is discussed below with regard to claims 26-28, 30, 34, 37, 40 and 42-43, thus representing an additional reason why claim 37 is allowable.

Claims 24 and 44: Claims 24 and 44 recite a lining element comprising an optical conductor. Claims 24 and 44 further recite that the optical conductor comprises at least one of polymethyl methacrylate and polycarbonate material having. *Polymethyl methacrylate and polycarbonate materials are materials that exhibit a relatively high degree of stiffness/rigidity.*

The Office Action recognizes that the alleged Baba - Anderson combination fails to explicitly teach the recitations of claims 24 and 44, but asserts that it would have been obvious to use the recited materials on the basis “of its suitability for the intended use.” However, these materials would not be suitable for use in the Baba-Anderson combination, thus failing the alleged *In re Leshin* test relied on in the Office Action. Specifically, Baba makes explicitly clear that his light guide member 110 is flexible: “Light guide member 110 is made of a transparent or translucent silicone rubber or resin having both flexibility and elasticity (a pull strength: 20 kg/cm² which permits the light guiding member 110 to be expanded two times its original length).” (Baba, col. 2, lines 61-65.) These stiff/rigid materials polymethyl methacrylate and polycarbonate are not suitable for intended use in Baba, which dictates a flexible material. Accordingly, the recitations of claims 24 and 44 would not be present in the device resulting from the combination of Baba and Anderson.

Claims 25 and 38: Claims 25 and 38 recite a lining element comprising a translucent covering layer. The covering layer comprises a layer of a gel-like substance covered toward the interior of the vehicle by a plastic film.

The Office Action attempts to rely on Parker to remedy the deficiencies of the Baba - Anderson combination pertaining to the additional recitations of claims 25 and 38. No evidence or rationale has been put forward establishing or even tending to suggest that Parker teaches the elements of claims 25 and 38. Indeed, the cited sections of Parker appear to teach nothing more than a genus of materials that will be assumed *arguendo* to include the species of gel-like substances. That is, all that the Office Action appears to assert is that because Parker teaches an “elastomeric or other flexible material,” *etc.*, Parker somehow meets the recitations of claims 25 and 38. This assertion in the Office Action completely vitiates the third requirement of MPEP § 2143 that each element be taught/suggested in the prior art references.

Moreover, the approach taken in rejecting claims 25 and 38 is entirely inconsistent with 35 U.S.C. § 112, fourth paragraph. That is, claim 24, from which claim 25 depends, and claim 31, from which claim 38 depends, recites that the covering layer is “elastically compressible.” Dependent claims 25 and 38 place further limitations on the covering layer recited in the respective independent claims. It is well established that dependent claims meeting the requirements of 35 U.S.C. § 112 (such as claims 25 and 38) must further limit the scope of the claim from which it depends. (*Pfizer, Inc. v. Ranbaxy Laboratories Ltd.*, 457 F.3d 1284, 79 U.S.P.Q.2d 1583 (Fed. Cir. 2006).) In the Office Action, the PTO rejects the claims in view of teachings that, at most, correspond to the broader scope of coverage in claims 24 and 31. Thus, even if a *prima facie* case of unpatentability had been made out against independent claims 24 and 31 (which it has not, as detailed herein), no such case has been made out with respect to at least dependent claims 25 and 38.

Claims 26-28, 30, 34, 37, 40, and 42-43: Claim 26-28, 30, 34, 37, 40 and 42-43 recite a lining element, comprising, variously, components of various thicknesses, components of specified optical transmissivity, components of specified hardnesses, and components of specified dynamic viscosities.

The Office Action cites to no specific teaching in the art which corresponds to the elements of these claims. The Office Action rejects these claims based on the sole allegation that “discovering the optimum or workable ranges involves only routine skill in the art,” citing the 1955 case *In re Aller*.

In re Aller is not a panacea which excuses the PTO from the third requirement of MPEP § 2143 or any of the other requirements for establishing a *prima facie* case of obviousness. The courts have put limits on examination of claims based on *In re Aller*. The MPEP explicitly tempers the use of *In re Aller* when rejecting claims. MPEP § 2144.05 II (Optimization of Ranges) addresses *In re Aller*, and makes clear that rejections of the kind proffered in the Office Action are only applicable when the optimization pertains to “result-effective variables.” Specifically, MPEP § 2144.05, in the very next sub-section after addressing *In re Aller*, states that, referring to *In re Antonine*,¹ that a

particular parameter must *first* be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonine* (citations omitted). (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.)

(Emphasis added.) As in *In re Antonine*, the Office Action provides nothing in the way of evidence or even allegation that there was a recognition in the prior art that there existed functionality between the recited elements and physical phenomenon flowing from the use of those elements. Because it has not yet been established that the missing elements of claims

¹ A 1977 case which thus is controlling legal authority with respect to the prior *In re Aller* case (decided in 1955).

26-28, 30, 34, 37, 40 and 42-43 are result-effective variables, a *prima facie* case of obviousness has not been established for these claims for yet another reason.

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In sum, even if the ordinary artisan would have sought to modify/combine the cited references, the third requirement of MPEP § 2143 is not satisfied in the Office Action, because the cited references do not teach each and every element of the present invention. Thus, the presently pending claims are allowable for at least this reason.

Insufficient Rationale For Combining / Modifying The Prior Art

Claims 16 and 35: Claim 16 (formerly pending claim 18) recites a lining element for the interior of a vehicle, which includes a translucent covering layer that *comprises an elastomer that has an at least partially foamed structure*. As a rationale for modifying/combining the prior art to arrive at formerly pending claim 18 (now claim 16), the Office Action asserts that the ordinary artisan would have used the foam of Anderson “in order to provide a simple, efficient and inexpensive cushioning means that may be easily accessed (*i.e., rip, tear, cut*) to facilitate repairs/modifications within the lighting device itself.” (Office Action, page 6, second full paragraph, emphasis added.) Not so.

To the extent that Baba teaches a component with a failure rate sufficiently high to command the formulation of a specific maintenance plan (an unlikely event, as in the 2001-2002 timeframe, the lamp 112 is in all likelihood a LED, which have failure rates well below the life expectancy of the vehicle), that maintenance plan, which would have been promulgated by established companies, would not have amounted to instructing a mechanic to “rip, tear, cut” into a lining element of an interior of their vehicle. Indeed, even if the underlying element 110 of Baba was foam, such would still require cutting through surface element 116, an action which would have been believed to leave an ugly “surface scar” clearly visible to the occupant after repair, the repaired cut/rip/tear also diffracting light passing through element 116 (this light that would have also increased the noticeability of the “surface scar.”) Along the same lines, Baba teaches that element 116 is a “liquid crystal

panel.” (Baba, col. 4, lines 1-2.) Ripping/tearing/cutting through a liquid crystal panel will destroy the panel. It is not something that the skilled artisan would have done.

Moreover, to the extent that a failure mode was identified to warrant a maintenance plan, the ordinary artisan would have planned for the entire panel removed and replaced.

In sum, the rationale articulated in the Office Action to modify the device of the Baba – Anderson combination is insufficient to establish a *prima facie* case of obviousness against claim 16. A *prima facie* case of obviousness has likewise not been established with respect to claim 35 for at least the pertinent reasons just discussed regarding claim 16.

Claims 22 and 37: The Baba-Anderson combination teaches away from the inventions of claims 22 and 37. As detailed above, the light from lamp 22 in Miller is not needed above mounting panel 13 (instead, it is needed to transmit through light 29). Indeed, the figures depict element 13 closely surrounding the base of the lamp, thus preventing light from the lamp from reaching the other side of panel 13. That is, the entire design depicted in the figures teaches a configuration where light from the lamp is prevented from reaching the other side of panel 13 (the mirror side). This is concomitant with the need to prevent light from reaching the mirror section of the exterior mirror. That is, the skilled artisan would have recognized that light traveling up towards the mirror section might distract the driver of a vehicle (*e.g.*, the driver might misinterpret light in the mirror area 126 as light from a car, etc.) Accordingly, the skilled artisan would not have used a translucent material for element 16 which would permit light to pass up into the mirror section.

MPEP § 2144.05(III), entitled Rebuttal Of *Prima Facie* Case Of Obviousness, states that a “*prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.” (MPEP § 2144.05(III), second paragraph, emphasis added, citations omitted.) In view of the above (Miller preventing light from passing up into the mirror section from the lamp), Applicant respectfully submits that to the extent that a case of obviousness has been established with respect to claims 22 and 37, that case is hereby rebutted.

Claims 24 and 44: The Baba - Anderson combination also teaches away from the inventions of claims 24 and 44. As detailed above, Baba makes quite clear that his light guide member 110 is flexible: “Light guide member 110 is made of a transparent or translucent silicone rubber or resin having both flexibility and elasticity (a pull strength: 20 kg/cm² which permits the light guiding member 110 to be expanded two times its original length).” (Baba, col. 2, lines 61-65.) Conversely, polymethyl methacrylate and polycarbonate are highly rigid materials. A rigid material is the opposite of a flexible material. Accordingly, pursuant to MPEP § 2144.05(III) (discussed immediately above), to the extent that a case of obviousness has been established with respect to these claims, that case is hereby rebutted.

New Claims

Applicant has added new claims 46 and 47. These claims recite that the mirror is an angled mirror. The term “angled” was present in all of the claims as previously pending, but has been removed from those claims by this amendment. Claims 46 and 46 simply recite the feature removed from the claims. These claims are allowable for at least the reason that they depend from allowable claims.

Applicant has cancelled a similar number of claims to ensure entry of these new claims.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,

otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Examiner Han is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date

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By

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